REMARKS

Claims 1-3 and 5-9 are resubmitted without amendment for reconsideration in the light of the following remarks and authorities. Claim 4 has been amended without narrowing to correct a minor informality. New claims 10 and 11 are patterned after claims 3 and 9, respectively and include the limitations recognized to be absent from the reference. Such amendments to claims are only for the purpose of advancing the prosecution of this application and are not to be construed as an abandonment of any of the novel concepts disclosed therein.

1, 2. Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kowaki. The reference is said to disclose an audio system which is comprised of a first directional audio channel signal source (SFL) and (SFR), a surround audio channel signal source (SRL) and (SRR), a first electroacoustical transducer coupled to the first directional audio signal and to the surround audio channel source, with specific reference to column 7, lines 4-10; the first electroacoustical transducer constructed and arranged to radiate sound waves corresponding to audio signals from the first directional audio channel signal source and corresponding to audio signals from the surround audio channel signal source, with specific reference to column 7, lines 11-12, a second electroacoustical transducer coupled to the first directional audio signal source (speaker for FL), the second electroacoustical transducer constructed and arranged to radiate soundwaves corresponding to audio signals from the first directional audio channel signal source (radiate signal FL), a first and a second audio scaling devices (different scaling devices are within matrix processing device 6), a second directional audio channel source (SCE), and a third electroacoustical transducer (speaker for RR). The reference does not disclose that a first transducer is situated behind a first passenger location, a second transducer is situated forward of a first transducer and a third transducer is situated behind a second passenger location. However, even though the reference does not explicitly disclose exact locations for the speakers as claimed, it is said it would have been obvious to one skilled in the art to situate the speakers as claimed because it would have been merely a design choice to have the speakers situated at different locations within a vehicle.

This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

> [I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

Nothing in the reference suggests the desirability of modifying what is there disclosed to meet the terms of the rejected claims.

The contention by the Examiner that it would have been obvious to one skilled in the art to situate the speakers as claimed because it would have been merely a design choice to have the speakers situated at different locations within a vehicle is a conclusion, not a reason.

In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

Accordingly, if this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in each rejected claim that has not been previously identified and quote verbatim the language in the reference regarded as suggesting the desirability of modifying what is there disclosed to meet the terms of each rejected claim.

New claims 10 and 11 have been added patterned after claims 3 and 9, respectively, and include the limitations conceded as being absent from the reference. Accordingly, these claims are submitted to be properly allowable in this application.

In view of the foregoing authorities, remarks and inability of the art, alone, or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

Enclosed is a $110 check for the Petition for Revival of an Application for Patent Abandoned Unavoidably Under 37 CFR 1.137(a) fee. Please apply any other charges or credits to deposit account 06-1050, Order No. 02103-399001.

Respectfully submitted,

FISH & RICHARDSON P.C.

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Charles Hieken
Reg. No. 18, 411

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
Attorneys for Application Owner

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